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MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			EXAMINER DALENCOURT, YVES	
			ART UNIT 2457	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/027,302

Examiner

YVES DALENCOURT

Applicant(s)

BOUET, STEPHANE

Art Unit

2457

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2008.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-12, 14-15, 18-20, 22-24 and 27-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-12, 14-15, 18-20, 22-24, and 27-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is responsive to communication filed on 11/07/2008.

Response to Amendment

The Examiner has acknowledged the amended claims 1, 3, 11, 12, 18 - 20, 22 - 24, 29, and 35 – 41.

Response to Arguments

Applicant's arguments filed on 11/07/2008 have been fully considered but they are not persuasive.

Regarding Applicant's argument that Dan also fails to teach "at least one of the plurality of packets of the ongoing packets transfer comprises a header portion and a separate payload portion. The argument is moot because the Examiner did not rely on Dan for such. Dan, however, was cited for the idea of having a portion of the image data transmitted in the header packet. See lines 10-35, column 10 for the description of "device." wherein the picture data is transmitted in one or more headers of one or more of the plurality of packets of the ongoing packet transfer.

Regarding Applicant's argument (page 13, last paragraph) that there is no picture shape data contained in the header portion of the packet in Kitamura. The Examiner respectfully disagrees with Applicant's assertion because Kitamura was cited for the limitation of "an ongoing packet transfer comprising a header portion and a separate payload portion (see abstract; col. 2, lines 15 – 61; col. 13, lines 43 – 49; Kitamura

discloses a sub image data packet is composed of three types of data that are a sub image header, sub image display data, and sub image control data). Dan was already cited for having a picture in the header of an ongoing transfer packet.

In response to applicant's argument (pages 14 - 16) that the combination of the prior art applied does disclose or suggest Applicant's claimed invention, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

It appears that applicants are interpreting the claims very narrow without considering the broad teaching of the references used in the rejection. Applicants are reminded that the examiner is entitled to the broadest reasonable interpretation of the claims. The Applicants always have the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In *re Prater* 162 USPQ 541, 550-51 (CCPA 1969).

In view of such the rejection is sustained and maintained as follow:

Claim Objections

Claims 11, 24, 29, 36, 37, and 38 are objected to because of the following informalities: It is suggested to delete "configure to" (claim 11, lines 2, 11, 13; claim 24, line 2; claim 29, lines 2, 12; claim 36, lines 4, 7, 12, 15; claim 37, lines 4, 9; claim 38, lines 4, 11, 14), because it has been held that the recitation that an element is "configured" to perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 11, 18, 19, 22, 24 – 33, and 40 - 41 are rejected under 35 U.S.C. 103(a) as being obvious over Dan et al (Dan hereinafter) in view of Kitamura et al (US 5,999,160; hereinafter Kitamura).

In reference to claims 1, 40, and 41, Dan shows a method comprising:
transmitting, during an ongoing packet transfer operation in which packets of content are transferred between a sending device and a receiving device, picture data in addition to said content [See Fig. 1 for Browser and Web Server. See Fig. 21 for picture

data in addition to said content, or see lines 20-29, column 17 for including "banner object", which is a picture in the header] wherein said packet transfer is comprised of a plurality [Each unit of information is given in a single "packet" or an HTML document]; at least portion of said picture data for display on a display associated with the receiving device during said ongoing packet transfer [The server or browser transmits "the picture"] for display on a display associated with the receiving device during said ongoing packet transfer, Display is the web browser, See line 41-44, column 9. HTTP protocol allow display of downloaded objects prior to the completion of the page transfer, or in other words, during packet transfers. See lines 10-35, column 10 for the description of "device." wherein the picture data is transmitted in one or more headers of one or more of the plurality of packets of the ongoing packet transfer. [As discussed above, the image data is carried within "header" of the packets. The header is, of course, header of the html document. The packets carry the header.]

In Fig. 21, Dan does not show that the banner is in "addition to said content." It would have been obvious to one of ordinary skill in the art at the time of the invention to have web page content, so that the web page header information is sent "in addition" to the web page content.

Dan also fails to teach that at least one of the plurality of packets comprises packet transfer comprises a payload portion and a separate header portion.

However, Kitamura teaches an analogous method for forming sub image data packet including data of sub image superimposed on main image, which discloses the idea of having at least one of the plurality of packets comprises packet transfer

comprises a payload portion and a separate header portion (see abstract; col. 2, lines 15 – 61; col. 13, lines 43 - 49).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Dan by incorporating at least one of the plurality of packets comprises packet transfer comprises a payload portion and a separate header portion as evidenced by Kitamura for the purpose allowing the display position, the display size, and the display color to be changed for each display unit of the main image, thereby reducing the amount of data to be transmitted.

In reference to claim 3, Dan and Kitamura show all the limitations, and Dan shows that the at least a portion of the picture data includes at least one picture for transmission to the receiving device. [See lines 20-29, column 17 for including "banner object", which is a picture].

Claims 11 - 12 substantively restate the limitations of claims 1 and 3, but in more general terms, and in apparatus form rather than in method form. The reasons for the rejections of claims 1 and 3 apply to claim 11.

In reference to claim 18, Dan and Kitamura do not show that the headers include parameters that control the display of the image data on a display of the receiving device during the ongoing packet transfer. However, Dan shows HTML tags and their use for creating HTML documents.

It would have been obvious to one of ordinary skill in the art at the time of the invention to insert image and its associated display parameters in the banner (in Fig. 9)

using <MG src= "filename" width=y height=y> tag of HTML, so that the displayed image fits in the page that displays the image.

In reference to claim 19, Dan and Kitamura do not show to claim 1 wherein the picture data is displayed in lieu of content during said ongoing packet transfer. However, Dan shows HTML tags and their use for creating HTML documents.

It would have been obvious to one of ordinary skill in the art at the time of the invention to insert image and its associated display parameters in the banner (in Fig. 9) using tag of HTML, so that in lieu of text data, the image data is displayed.

Claim 24 substantively restate the limitations of claim 1, but in apparatus form rather than in method form, respectively. The reasons for the rejections of claim 1 apply to claim 24, respectively.

Claims 22 and 27 substantively restate the limitations of claim 18, but in apparatus form rather than in method form. The reasons for the rejections of claim 18 apply to claims 22 and 27.

Claim 28 substantively restates the limitations of claim 19, but in apparatus form rather than in method form. The reasons for the rejections of claim 19 apply to claim 28.

Claim 29 substantively restates (in broader manner) the limitations of claims 1, even though limitations are phrased differently and they are addressed to apparatus. The reasons for the rejections of claim 1 apply to claim 29.

Claims 30 and 31 substantively restate the limitations of claims 16, and 17 (now cancelled), but in apparatus form rather than in method form, respectively. The reasons for the rejections of claims 16 and 17 apply to claims 30 and 31, respectively.

Claims 32 and 33 substantively restate the limitations of claims 18 and 19, but in apparatus form rather than in method form. The reasons for the rejections of claims 18 and 19 apply to claims 32 and 33.

Claim 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dan and Kitamura in view of Hines et al (Hines hereinafter).

In reference to claim 5, Dan and Kitamura do not show but Hines shows embedding MPEG in HTML [See claim 3 of Hines]. Hines meets claim 5's limitations because MPEG format contains fields that are stated in claim 5's limitation. The reference document Dali: MPEG Video - C API explains MPEG format.

As Dali: MPEG Video - C API reference shows, MPEG format meets the following elements of claim 5: at least one field selected from the group consisting of a field for specifying the size of the picture series [See numElements of MpegVideoIndex, in page 4], a field for specifying the length of time the picture is displayed [See picture rate of MpegSeqHdr in page 1, which specifies the time delay between frames], a field for specifying the size of the picture [See width and height in MpegSeqHdr in page 1], and a field for the picture data [The body of MPEG file contains video or "picture data."].

In reference to claim 6, Dan and Kitamura do not show but Hines shows embedding MPEG in HTML [See claim 3 of Hines]. As Dali: MPEG Video - C API reference shows, MPEG format meets the following elements of claim 6: subsequent

header for a subsequent picture in the series includes a field for indicating the last picture of the series [See SEQ END-CODE under Start Codes section, page 6],

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dan and Kitamura in view of Bell.

In reference to claim 10, Dan and Kitamura do not show but Bell shows transmissions in accordance with the Object Exchange (OBF.X) transfer protocol in a short range communication operating environment [See lines 27-52, column 2 of Bell.].

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Dan's features with the above feature that Bell shows, because, as stated in lines 2933 of Bell, Bell's invention allows one to "[edited] convey, i. e., receive, transmit, or exchange, data objects of different types such as virtual business cards, virtual calendars, virtual notes, or any other suitable data objects."

Claims 4, 7, 14, 15, 20, 23, and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dan and Kitamura in view of Yu et al (Yu hereinafter).

In reference to claim 4, Dan and Kitamura do not show, but Yu shows that individual pictures are transmitted for display in succession on the receiving device to be viewed as a mini-clip. See lines 10-25 in column 7. Images are transmitted in reduced form.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Dan's features with the above feature that Yu shows, because, as stated in lines. 42-45 of Yu, Yu's invention "[edited/provides a generic solution to two-way communication mobile device that can effectively interact with a data network,

such as the Internet, for images." The mechanism allows one to deal with the problem described in lines 56-61, column 1 of Yu.

In reference to claim 7, Dan and Kitamura do not show but Yu shows the picture in segments is performed over multiple Application Parameters headers when the picture is too large to fit into a single header. See Fig. 6A and from line 57, column 7 to line 32, column 8 of Yu. First, reduced images are sent when the images cannot be displayed in its full resolution. User can choose to see each subdivisions of the picture, in a specific number of iterations.

With respect to claim 14, Dan and Kitamura do not show but Yu shows that sending device is a wireless sending device [See item 108, Fig. 1 of Yu].

With respect to claim 15, Dan and Kitamura do not show, but Yu shows that the receiving device is a wireless mobile terminal having a graphics capable display, [See Fig. 2, Yu. Note that the illustrated device is capable of displaying graphics].

With respect to claim 20, Yu shows the image data and the content are transmitted wirelessly. See lines 10-25 in column 7. Images (and thus content) are transmitted in reduced form. See item 108, Fig. 1 of Yu. Data is transmitted wirelessly.

Claims 23 and 34 substantively restate the limitations of claim 20, but in apparatus form rather than in method form. The reasons for the rejections of claim 20 apply to claims 23 and 34.

Claim 35 contains rephrased versions of claims 24 and 27, in method form. The reasons for the rejections of claims 24 and 27 apply to claim 35.

Claim 36 contains rephrased versions of the limitations of claims 11, 24, 26, and 27, in apparatus form. The reasons for the rejections of claims 11, 24, 26, and 27 apply to claim 35.

Claim 37 substantively contains the limitations of claim 35, but in apparatus form. The reasons of the rejection of claim 35 apply to claim 37.

Claim 38 is substantively as same as claims 35-37, except that it cites: said receiving device further configured to remove the at least a portion the additional image data from the at least one content packet during the ongoing data transfer operation.

Yu shows that a large image is reduced in size. Thus, the original image is "removed" (it is also replaced by the reduced image). Note that the original image may still be viewed in Yu.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dan and Kitamura in view of Yu et al (Yu hereinafter) and further in view of Hines.

In reference to claims 8 and 9, their limitations have been discussed with respect to claims 5 and 6. The statement of obviousness with respect to the claims 5 and 6 are as same as those given during the discussion of claims 1, 3-7 and 10-15, in view of the references Dan, Hines, and Yu.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YVES DALENCOURT whose telephone number is (571)272-3998. The examiner can normally be reached on M-F 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/YVES DALENCOURT/
Primary Examiner, Art Unit 2457